(b) Remarks

1. It is first noted that the instant application is a new use for an existing product, namely, a glassine pleated paper used in the prior art to hold chocolate candies. Perlman [046]. (See also Exhibit A). It is alleged in the instant patent application that such glassine pleated papers are not known in the prior art for the purpose of holding specimens to be weighed in laboratory scales, or, for that matter, in any other scales.

The Patent Office has taken the position that a new use for an old product can be novel if it is claimed as a method. *Ex parte Muller*, 81 U.S.P.Q. 261, 261 (1947) (allowing a claim for the method of killing insects which comprises dissolving a known chemical compound in a solvent liquid and spraying the liquid onto insects). Furthermore, in the Patent Act of 1952, Section 100 (b) defined ''process'' as meaning "process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material," thus confirming Congress' intent to include new uses of known products as patentable subject matter. 35 U.S.C. § 100 (2005).

It has been found that many processes, which may be old in a procedural sense, become new when a new result is accomplished by the use of a new agent. *Ex parte Wagner*, 88 U.S.P.Q. 217, 220 (1950). In considering the patentability of such processes, the imperative criterion is not whether the steps themselves are shown in the prior art but whether the product used in conjunction with the process claimed is disclosed by the prior art. *Id.* Therefore, if the process and the particular use of the material are not suggested by the prior art, the process claims are novel and patentable. *Id.*

Applicant acknowledges the existence of such containers in the prior art. Perlman [0035]. (See also Exhibit B). Based on the criteria stated supra the present application should be allowable.

In addition, a product used in the candy industry, baking industry, or coffee industry, does not readily lend itself to a rejection for obviousness when used by chemists for weighing of chemical sample materials. See also p13 line 18 *Infra.*

2. The applicant next notes that the word "glassine" does not describe a coating on paper, but rather is a glaze on the surface of the paper. Exhibit B.

3. The applicant next disagrees with the Examiner's construction of claim1 regarding the preamble. The preamble is necessary because it introduces the "weighing instrument" which is then referenced later on in the claim. Without the preamble there would be no antecedent for the phrase "said instrument" in the line: "placing said weighing dish on a weighing surface of said instrument;" as it appears in claim 1.

The *Kropa* Court, cited by the Examiner, states "On the other hand, in those * * * cases where the preamble to the claim * * * was expressly or by necessary implication given the effect of a limitation, the introductory phrase was deemed essential to point out the limitation defined by the claim or count. In the latter case of cases the preamble was considered necessary to give life, meaning, and vitality to the claims. *Kropa v. Robie*, 187 F.2nd 150 at 152.

4. US Patent 2,459,073 cannot anticipate the current invention because said patent does not contain each and every element of any claim in the present invention, as required for anticipation. " * * * [a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore &*

Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554 (Fed. Cir., 1983).

In claim 1 of the current application the following elements are not disclosed or claimed by the '073:

(a) A method of weighing a quantity of dry substance on a weighing instrument,

(b) providing a paper weighing dish with at least one surface that is lubricious and substantially impermeable to finely powdered dry chemicals; and

(c) effecting a substantially quantitatively transfer of said substance by sliding said substance into a receiving vessel.

4. The combination of US Patent 2,459,073 (*Hamilton*) with US Patents 4,878,552 (*Gebo*) and 4,606,496 (*Marx*) to constitute a rejection based on obviousness for the following reason:

(a). **Prior Art Not Analogous**

Hamilton and *Marx* are not analogous prior art because they are neither in the field of endeavor of the present invention nor reasonably pertinent to the specific problem with which the present invention is involved. *In re Deminski*, 230 USPQ 313, 315 (Fed. Cir. 1986). *Gebo* is not

reasonably pertinent to the specific problem with which the present invention is involved. *Id.*

The problem with which the present invention is involved is stated in the application as follows:

"It is an object of the present invention to provide an inexpensive weighing dish which has all of the requisites for its intended purpose: namely, it is easy to use, it prevents contamination of the material to be weighed, and it provides for an easy and substantially complete transfer of the material to and from the weighing dish. " Perlman [004]

The inventor is a chemist and molecular biologist. See exhibit 'C. Such a person would not be expected to have knowledge regarding the manufacturing of paper products.

Hamilton teaches the manufacturing of paper cups. (Furthermore, *Hamilton* teaches the use of multiple layers in such manufacture, while the present invention does not. *Hamilton* Figs 2,3,5,6,8, and 9.) *Gebo* teaches the manufacture of rigid paperboard containers. Thus, neither *Hamilton nor Gebo* is not presumed to be known to the inventor because it is not in the field of endeavor of the inventor, but rather in the field of paper product manufacturing.

Furthermore, neither *Hamilton nor Marx nor Gebo* are analogous prior art because they are not reasonably pertinent to the problem that the inventor of the present invention was trying to solve.

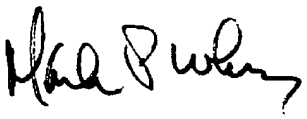
> "A reference is reasonably pertinent …. if it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem…. [I]f an invention is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it."

In re Clay, 23 USPQ.2d 1058, 1061 (Fed. Cir. 1992). The object of both *Hamilton and Gebo* are the manufacture of paper products for general use. They cannot be considered reasonably pertinent to the problem being solved in the present invention, because neither would be acceptable for use with laboratory scales. Neither *Hamilton nor Gebo* deals with the problem of not retaining powder which might stick to the surface. Thus, neither is analogous prior art which teaches the present invention. *Marx* is concerned with shielding a laboratory sample from magnetic fields nearby. *Marx*, ABSTRACT. Thus *Marx*, although dealing with a laboratory scale, in therefore in the field of endeavor, is concerned with a totally different purpose than the present invention, and for that reason would not be analogous art.

For the foregoing reasons, the Applicant submits that the Disposable Paper Weighing Dishes disclosed and claimed in the present application is not fairly taught by any of the references of record, either taken alone or in combination. Therefore, allowance of the present application is in order, and is requested.

The Commissioner is hereby authorized to charge any additional fees due to my deposit account, 231706.

Respectfully submitted



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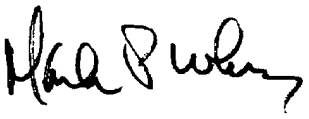

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